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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/516,678 | 12/03/2004 | Mitsutoshi Shinkai | 450100-05033 | 6633 |
| 7590 | 01/28/2008 | | EXAMINER | |
| William S Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151 | | | DANG, HUNG Q | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2621 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 01/28/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 10/516,678 | SHINKAI ET AL. | |
| | Examiner | Art Unit | |
| | Hung Q. Dang | 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 December 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 December 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/03/2004, 03/26/2007.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. .
5) Notice of Informal Patent Application
6) Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 recites “a program for causing a computer to perform recording-control processing” of data. However, it appears that such would reasonably be interpreted by one of ordinary skill in the art as software, *per se*. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

However, in contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035 (MPEP 2106.01.I).

Accordingly, the examiner suggests amending the claim to “a computer-readable medium encoded with a software program” or equivalent in order to make the claim statutory. Any amendment to the claim would be commensurate with its corresponding disclosure.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. Sec. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. Sec. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Claim 10 recites series of data recorded on a storage medium. Pure data do not impart functionality to a computer or computing device, and are thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a

computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 10 defines a storage medium for recording series of data, which are nonfunctional descriptive material as discussed above. Further, the claim does not define a computer-readable medium or memory and is thus also non-statutory for that reason (i.e., "when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed control information can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim would be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 6-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Brook et al. (US 2003/0146915).

Regarding claim 1, Brook et al. disclose a recording control apparatus for controlling recording of first, second, and third data series onto a storage medium ([0277], [0280], [0282], [0151], and [0290]), the apparatus is characterized by comprising: first data extracting means for extracting data having a first data amount from the first data series ([0277]), the first data amount being a data amount in accordance with a data amount required for reproduction for first reproduction time ([0277] with first reproduction time being the reproduction time of the media data); second data extracting means for extracting data having a second data amount from the second data series, the second data amount being a data amount in accordance with a data amount required for reproduction for second reproduction time that is different from the first reproduction time ([0280], [0282]); first recording-control means for performing recording-control to record data having the first data amount for the first data series and data having the second data amount for the second data series onto the storage medium so that the respective data are periodically arranged ([0277], [0280], [0282]; Fig. 22; [0307]; Fig. 28); and second recording-control means for performing recording-control to record the third data series onto the storage medium so that the third data series is arranged at random independently of the first data series and the second data series ([0290]).

Regarding claim 6, Brook et al. also disclose the first data series is a data series of video or a data series of audio associated with the video ([0277], [0280]); the second data series is a data series of metadata that requires a real-time characteristic for the data series of video or the data series of audio associated with the video ([0280], [0282]); and the third data series is a data series of metadata that does not require a real-time characteristic for the data series of video or the data series of audio associated with the video ([0151], [0290]).

Regarding claim 7, Brook et al. also disclose for each clip that constitutes the material data in a predetermined area in the first data series, the third data series uses one file containing one of at least an LTC/UMID, GPS data, front-end time code, discontinuous-point time code information, a front-end extended UMID source pack, and a discontinuous-point extended UMID source pack ([0151]).

Claim 8 is rejected for the same reason as discussed in claim 1 above.

Claim 9 is rejected for the same reason as discussed in claim 1 above.

Claim 10 is rejected for the same reason as discussed in claim 1 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brook et al. (US 2003/0146915) as applied to claims 1 and 6-10 above and further in view of David (US 2002/0131763).

Regarding claim 2, see the teachings of Brook et al. as discussed in claim 1 above. However, Brook et al. do not disclose the first data amount is a data amount that is an integral multiple of a data amount in a physical unit area of the storage medium and that is close to a data amount required for reproduction for the first reproduction time; and the second data amount is a data amount that is an integral multiple of a data amount in the physical unit area of the storage medium and that is close to a data amount required for reproduction for the second reproduction time.

David discloses the first data amount is a data amount that is an integral multiple of a data amount in a physical unit area of the storage medium and that is close to a data amount required for reproduction for the first reproduction time ([0040]; [0008], [0009], [0046], [0047]); and the second data amount is a data amount that is an integral multiple of a data amount in the physical unit area of the storage medium and that is close to a data amount required for reproduction for the second reproduction time ([0010], [0040]; [0046], [0047]).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of David into the recording control apparatus disclosed by Brook et al. because, according to David, the taught feature can facilitate the reading, writing, and modifying of the data ([0012]).

Regarding claim 3, David also discloses the physical unit area is a minimum area to/from which data writing/reading is performed or an area in which an ECC block on which ECC processing is performed is recorded ([0008], [0009], [0010]).

Regarding claim 4, David also discloses the first recording-control means causes the data having the first data amount for the first data series and the data having the second data amount for the second data series to be recorded onto the storage medium so that boundaries of the respective data match boundaries of physical unit areas of the storage medium ([0008], [0009], [0010], [0041], [0042]).

Claim 5 is rejected for the same reason as discussed in claim 3 above.

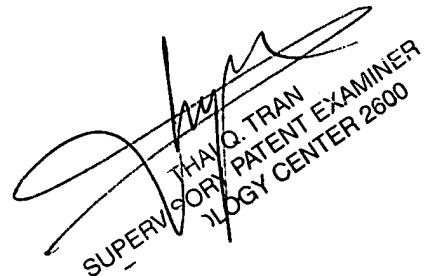
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is 571-270-1116. The examiner can normally be reached on M-Th:7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hung Dang
Patent Examiner



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